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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,669	02/15/2002	Yann Limelette	76.0715	3000

7590

04/14/2003

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EXAMINER

WALSH, DANIEL I

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 04/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

10/077,669

Applicant(s)

LIMELETTE ET AL.

Examiner

Daniel I Walsh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Specification

1. The abstract of the disclosure is objected to because of the following reasons:

Re line 12, remove "Figure 1".

Replace "Summary" at the top of the page with -- Abstract --.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Hansen et al. (US 6,315,206).

Hansen et al teaches a card wrapping with an opaque area that covers at least partially the confidential information (PIN 75, printed on the rear panel of the card) through rear panel 14 (see FIG. 6). Hansen et al. teaches a transparent area which covers at least partially the non-confidential information, through front panel 12, with opening 50, and "If desired, a transparent window (not shown), such as a transparent plastic film, can be secured in the opening 50 to protect the front surface of the card 16" (col 6, lines 1+). It is taught that a card front can have

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graphics on it (col 1, line 45), as is well known and conventional in the art, and therefore is interpreted as non confidential information, that would we covered by the transparent window.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3 Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. in view of Fehrman et al. (US 6,193,163).

The teachings of Hansen et al. have been discussed above, where Hansen et al. teaches the card has a main body comprising the confidential information.

Hansen et al. fails to teach an integrated circuit module that is detachable from the main body.

Fehrman et al. teaches an integrated circuit module that is detachable from the main

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body (see FIG. 1). Further, chip cards are well known to include graphics/indicia/non-confidential information on the front, and confidential information on the rear, as seen by the American Express Blue card, chip based phone cards, or metro smart cards where graphics (non-confidential) are printed on the front, but on the rear confidential information (numerical card number information) is printed, for example.

At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Hansen et al. with those of Fehrman, in order to have a way to protect credit cards that include chip cards, thus providing more applications/uses for the packaging.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al., as applied to claim 1, above.

The teachings of Hansen et al. have been discussed above.

Re claim 3, Hansen et al. teaches that the confidential information printed on the rear include a PIN, but fails to teach it includes a personal unblocking key. However, it is well known in the art and conventional, to print information on cards for enhancing identification, security, etc., as seen with credit card, debit cards, smart cards, phone cards, etc, where an account number, or PIN, or unique identifier is printed. Further, PUK (personal unblocking keys) are well known and conventional in the art for unblocking cards that have been blocked for security reasons, (see Uusitalo US 6,366,77; col 3, lines 40+, which teaches the use of a PIN and PUK with a card). Therefore, simply printing additional information on the card (PUK) that is well known and conventional in the art as a security measure to ensure authorized access, is well within the ordinary skill in the art, and therefore obvious, especially in light of printing PINs to

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permit usage of the card, motivated by providing more security related information to the card holder (i.e. PIN/PUK, etc.) to permit usage of the card.

5. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al, in view of Matheis et al. (US 6,349,829).

Hansen et al. teaches a card with confidential and non-confidential information in visible form, where the confidential information (PIN 75) is wrapped with an opaque is to cover at least part of it, through rear panel 14 (see FIG. 6). Hansen et al. teaches a transparent area which covers at least partially the non-confidential information, through front panel 12, with opening 50, and "If desired, a transparent window (not shown), such as a transparent plastic film, can be secured in the opening 50 to protect the front surface of the card 16" (col 6, lines 1+). It is taught that a card front can have graphics on it (col 1, line 45), as is well known and conventional in the art, and therefore is interpreted as non-confidential information, that would be covered by the transparent window. Though Hansen et al. is silent to providing a card with non-confidential and confidential, it is well known and conventional that credit cards, debit cards, phone cards, etc. (as taught by Hansen et al.) are provided with confidential and non-confidential information.

Hansen et al. is silent to when the wrapping occurs.

Matheis et al. teaches that the wrapping occurs after the personalization step through FIG. 2, which teaches that a card is packaged, and it is understood that this is after personalization (interpreted to include immediately after personalization) since a card cannot be packaged for sale, until it has completed a personalization step, as is well known and conventional in the art, since the cards need to be ready for use, upon removal from the packaging/wrapping.

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At the time the invention was made, it would have been obvious to an artisan of ordinary skill in the art to combine the teachings of Hansen et al. with those of Matheis et al.

One would have been motivated to do this in order to ensure that various cards are ready for use, upon removal from their packaging, as is well known and conventional in the art.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Finkelstein et al. (US 6,176,430), Young (US 5,975,302), Haghiri-Tehrani (US 5,677,524), Sprague et al. (US 5,842,629), Dawson (US 6,454,165), Klure (US 6,439,613), Risser (US 5,326,964), Bergeron et al. (US 4,882,473), Uusitalo (US 6,366,777), Fidalgo et al. (US 6,448,638), and Orihara (JP02000247082A)

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Walsh whose telephone number is (703) 305-1001. The examiner can normally be reached between the hours of 7:30am to 4:00pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for this Group is (703) 308-7722, (703) 308-7724, or (703) 308-7382.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [daniel.walsh@uspto.gov].

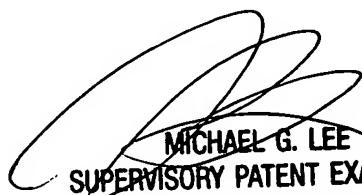
All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that

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sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.

DIW
4/1/03



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